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AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WALTER W. MOSHER JR., MICHAEL L. BEIGEL and THOMAS P. MAHONEY

Appeal No. 2001-1638
Application No. 09/033,832

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 19 to 25
and 27, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellants' invention relates to RF (radio frequency) identification devices designed to permit the transmission of information about a person or thing to whom or which the RF identification devices are secured (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

de Jong	4,612,719	Sep. 23, 1986
Hayes	4,718,374	Jan. 12, 1988
Pennock et al. (Pennock)	5,140,946	Aug. 25, 1992

Claim 20 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claim 25 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hayes.

Claims 19 to 25 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes.

Claims 19 to 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pennock in view of Hayes.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed July 26, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed July 13, 2000) and reply brief (Paper No. 15, filed September 22, 2000) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We sustain the rejection of claim 20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

The failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

In this rejection under 35 U.S.C. § 112, second paragraph, the examiner determined (answer, p. 3) that claim 20 was indefinite because there was no antecedent basis for "said circuit means." The appellants argue (brief, p. 6; reply brief, pp. 2-3) that the rejection is not well founded since the claimed "said circuit means" of

claim 20 is referring back to the "radio frequency identification circuit" recited in parent claim 19.

In our view, the scope of claim 20 would not be reasonably ascertainable by those skilled in the art. Thus, claim 20 is indefinite. In that regard, one skilled in the art would not be reasonably able to ascertain if the reference to "said circuit means" in claim 20 is (1) referring back to the "radio frequency identification circuit" recited in parent claim 19,¹ (2) adding a reference to a "circuit means" other than the "radio frequency identification circuit" recited in parent claim 19, or (3) changing the "radio frequency identification circuit" recited in parent claim 19 to be a means clause (i.e., radio frequency identification circuit means).² In view of this uncertainty, the metes and bounds of claim 20 has not been set forth with a reasonable degree of precision and particularity.

For the reasons set forth above, the decision of the examiner to reject claim 20 under 35 U.S.C. § 112, second paragraph, is affirmed.

¹ If this was the case the appellants could have easily amended claim 20 to overcome this rejection by amending "said circuit means" in claim 20 to read "said circuit" or more precisely "said radio frequency identification circuit."

² The scope of "radio frequency identification circuit" may be different from the scope of "radio frequency identification circuit means."

The anticipation rejection

We sustain the rejection of claim 25 under 35 U.S.C. § 102(b) as being anticipated by Hayes.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 25 reads as follows:

Reusable securement means having a body with securement portions thereupon, said securement portions being demountably engagable with opposite extremities of disposable attachment means to maintain said attachment means on an object or individual, said body having radio frequency identification circuit means embedded therein.

Hayes' invention relates to animal ear tags, and more particularly, to a multiple purpose ear tag assembly comprising a main tag member and a tag attachment member and which may include an insecticide member and attachment means, and an electronic identification signal generating means. In general, the two piece ear tag assembly 20 comprises an identification member 22 made of one piece of resilient molded plastic material and an attachment member 24 made of one piece of relatively rigid, but also resilient molded plastic material, which assembly is adapted to be mounted on the ear 26 of a bovine type animal as shown in Figures 1-3.

The identification member 22 comprises a flat relatively thin enlarged identification portion 40 having a generally polygonal peripheral configuration, a first reduced tapered width vertically extending intermediate connecting portion 42, a second further reduced tapered width rearwardly inclined intermediate portion 44, a narrow width vertically downwardly extending strap portion 45 and an enlarged connecting head portion 46 which is connectably associated with attachment member 24. The identification portion 40 is adapted to bear suitable visual identifying indicia 47 applied to a forwardly facing front marking surface 48. Strap portion 45 has parallel side edge surfaces 53, 54 and extends downwardly through a vertical slit 70 in the animal ear area 36, and through a central vertical passage 55 (see Figure 5) in attachment member 24. Head portion 46 has upwardly facing abutment surface means

56, 57 engaging downwardly facing lower surface abutment means on flexible rib portions 58, 59 of attachment member 24. A conventional active or passive electronic signal sending means 60 may be suitably mounted on or attached to the identification member 22. In one embodiment, means 60 is mounted on upwardly rearwardly inclined connecting portion 44 for sending a coded electronic identification signal to an electronic signal receiving means 62.

Figures 4 and 5 of Hayes show an attachment tag member 64 attached to identification member 22 by suitable attachment means 66. The insecticide tag attachment means 66 comprises an elongated slot defined by a flat bottom surface 100 and a pair of inclined side surfaces 102, 104 on flexible lip portions 106, 108 integrally molded in portion 42. Insecticide tag means 64 comprises a rectangular block-shape piece of conventional extrusion molded resilient flexible plastic and includes an integrally molded elongated rib portion 116 having a flat outer side surface 117 and inclined side surfaces 118, 119 which correspond to slot surfaces 100, 102, 104 so as to enable rib portion 116 to be inserted in and removed from the slot.

Hayes teaches (column 5, lines 36 et seq.) that

[i]n one presently proposed embodiment of the invention, the identification signal generating means 60 on the ear tag is a conventional electronic chip device with conventional miniaturized electronic circuitry and an antenna which is capable of receiving activating electromagnetic energy and responding thereto

by emitting a coded radio frequency digital signal. The identification signal receiving means is a conventional device which generates electromagnetic energy for actuating the identification signal generating means and which is capable of receiving, decoding, transmitting an analog signal. Both the identification signal generating means and the identification signal receiving and transmitting means may be of the same general design as apparatus currently manufactured and sold by B. I. Corporation of Boulder, Colo., and described in U.S. Pat. No. 4,475,481, the disclosure of which is incorporated herein by reference; but may also be other designs including the type wherein the signal generating means is battery operated and does not depend on receipt of activating energy from the signal receiving means. The identification signal receiving means 62 activates the ear tag signal generating means 60 by transmitting an electromagnetic field burst of fixed duration. The signal generating means 60 acquires energy from the field and responds by transmitting back to the generating means a radio frequency digital coded message signal which contains the unique number programmed into the electronic chip device. The generating means receives the coded signal and conditions it into a data signal that can be sent to electronic data processing means.

The animal identification signal transmitting means 60 may be encased in plastic, is of relatively small size, e.g., approximately 15 to 25 mm X 15 to 25 mm X 3 to 5 mm, or less, and of relatively low weight, e.g., 5 to 10 grams. The range of transmission of both the transmitting means and the receiving means is preferably limited to approximately between six inches to 3 feet, and the data storage capacity is approximately at least twenty to thirty binary digits (bits) of data plus other digits for preamble and parity (error detection) so that the system allows for up to 1,000,000 or more different unique codes which may be programmed into the electronic chip during manufacture.

In our view, claim 25 is met by Hayes. Claim 25 is readable on Hayes as follows:

Reusable securement means (Hayes' identification member 22 is clearly a securement means since it is secured to an animal's ear and is capable of being reused if and when attachment member 24 breaks or needs to be replaced) having a body with securement

portions thereupon (Hayes' identification member 22 comprises portions 40-46 including connecting head portion 46 to secure attachment member 24 thereto and portion 42 with insecticide tag attachment means 66 to attach insecticide tag means 64 thereto), said securement portions being demountably engagable with opposite extremities of disposable attachment means to maintain said attachment means on an object or individual (Hayes' connecting head portion 46 and insecticide tag attachment means 66 are capable of being demountably engagable with opposite extremities of a suitable disposable attachment means to maintain the attachment means on an object or individual), said body having radio frequency identification circuit means embedded therein (Hayes' identification member 22 has a identification signal generating means 60 that receives and transmits a radio frequency).

The argument presented by the appellants in the briefs does not convince us that the subject matter of claim 25 is novel. Specifically, we disagree with the appellants' argument that Hayes' identification member 22 is not reusable. In that regard, while Hayes does not specifically teach that his identification member 22 is reusable, it is readily apparent to us that since the identification member 22 is made of resilient molded plastic material, it inherently possesses the capability of being reused such as when the attachment member 24 breaks or needs to be replaced. Likewise, while Hayes does not specifically teach that his identification member 22 is

demountably engagable with opposite extremities of a disposable attachment means to maintain the attachment means on an object or individual, it is immediately evident to us that Hayes' identification member 22 inherently possesses the capability of being demountably engagable with opposite extremities of a suitable disposable attachment means to maintain the attachment means on an object or individual.

Thus, the appellants' arguments concerning how the claimed securement means is used are unpersuasive. It should be remembered that claim 25 is directed to a reusable securement means, per se, not to a method wherein this particular securement means is used. It is well settled that the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. See In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); In re Yanush, 477 F.2d, 958, 959, 177 USPQ 705, 706 (CCPA 1973). Furthermore, it is our opinion that Hayes' identification member 22 would be fully capable of the uses recited in claim 25. Thus, it is our opinion that claim 25 is readable on Hayes.

For the reasons set forth above, the decision of the examiner to reject claim 25 under 35 U.S.C. § 102(b) is affirmed.

The obviousness rejection based on de Jong and Hayes

We sustain the rejection of claims 19 to 25 and 27 under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Claims 19 and 21 read as follows:³

19. A radio frequency device comprising:
disposable attachment means for locating said device on an object or an individual to be identified, said attachment means being a disposable wristband, said wristband having opposite extremities;
reusable securement means demountably engagable with the opposite extremities of said wristband to maintain said wristband in temporary operative relationship with and being separable from said extremities when said wristband is discarded; and
radio frequency identification circuit embedded in said securement means for reuse with said securement means with a replacement wristband after the disposable wristband has been discarded.
21. A radio frequency identification device comprising:
disposable attachment means having opposite extremities;

³ Claim 25, the only other independent claim on appeal, has been reproduced earlier in this decision:

securement means separably connected to said opposite extremities of said attachment means for maintaining said attachment means in temporary-operative relationship with an object or individual to be identified; and

radio frequency identification circuit means embedded in said securement means and being removable with said securement means from said attachment means for subsequent use with replacement attachment means.

de Jong's invention concerns a holder for an electronic detection element adapted to be attached by means of a band around the neck or around a different part of the body of an animal to be detected. Figure 1 shows a first embodiment of the holder wherein a detection element 2 diagrammatically shown is embedded. At the bottom of the holder there is pivotally provided a flap 3 at one end at 4, which flap serves for clamping one of the ends of a band 6. Figure 3 shows a second embodiment of the holder wherein the responder 2 is embedded in the cavity of the flap 3 and consequently is integral with the flap, but, as shown, this embodiment may also be provided with retaining lugs 11, which are adapted to detachably retain through snap action a loose responder block. Figure 8 shows another embodiment in which a wedge 80 is fitted at the bottom with teeth to clamp respective ends of the band 6. In this embodiment, the responder block 2 is detachably retained in the appropriate cavity in the holder by retaining lugs 81, which are comparable with the retaining lugs 11 of Figure 3. Finally, Figure 9 shows a variant in which the band ends are each provided between and about three ribs 90, 91 and 92 integral with the holder and designed as shear pins.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The examiner ascertained (answer, p. 4) that the embodiments of Figures 8 and 9 of de Jong do not disclose that the responder includes a radio frequency identification circuit or that the responder is embedded in the securement means. With regard to these differences, the examiner then determined (answer, p. 4) that (1) "[i]n view of the teachings of Hayes it would have been obvious [at the time the invention was made] to one [of ordinary skill] in the art to modify de Jong by including a radio frequency identification circuit means within the responder since this would allow information from the responder to be sent out and received in an easier manner," and (2) "[i]n view of the teachings of figure 1 of de Jong it would have been obvious [at the time the invention was made] to one [of ordinary skill] in the art to modify figures 8 and 9 of de Jong by embedding the responder within the securement means since this would allow the responder to be attached to the securement means in a more secure manner.

The argument advanced by the appellants in the briefs does not convince us of any error in the above-noted determinations made by the examiner. In that regard, the appellants' argument that no piece of prior art teaches a securement means with an

embedded RFID (radio frequency identification) circuit removably associated with a disposable attachment means is not germane to this rejection since this rejection is under 35 U.S.C. § 103, not 35 U.S.C. § 102. In this case, it is our opinion that the combined teachings of de Jong and Hayes would have made the subject matter of claims 19, 21 and 25 obvious at the time the invention was made to a person of ordinary skill in the art for the reasons set forth above.

For the reasons set forth above, the decision of the examiner to reject claims 19, 21 and 25 under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes is affirmed.

Dependent claims 20, 22 to 24 and 27 have not been separately argued by the appellants. Accordingly, we have determined that these claims must be treated as falling with their respective independent claim. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and 37 CFR §§ 1.192(c)(7) and 1.192(c)(8)(iv). Thus, it follows that the decision of the examiner to reject claims 20, 22 to 24 and 27 under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes is also affirmed.

The obviousness rejection based on Pennock and Hayes

We will not sustain the rejection of claims 19 to 25 under 35 U.S.C. § 103 as being unpatentable over Pennock in view of Hayes.

Pennock's invention relates generally to illuminated pet collars, and more particularly to a pet collar which includes a removable transparent tube into which a plurality of lights are operably connected for viewing.

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

In our view, the only suggestion for modifying Pennock's pet collar to include a radio frequency identification circuit as taught by Hayes stems from hindsight knowledge derived from the appellants' own disclosure.⁴ The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course,

⁴ Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellants. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, we see no motivation, suggestion or teaching in the applied prior art of Pennock and Hayes of the desirability of modifying Pennock to arrive at the claimed subject matter.

impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 19 to 25 under 35 U.S.C. § 103 as being unpatentable over Pennock in view of Hayes is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 20 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claim 25 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject claims 19 to 25 and 27 under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes is affirmed; and the decision of the examiner to reject claims 19 to 25 under 35 U.S.C. § 103 as being unpatentable over Pennock in view of Hayes is reversed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

AFFIRMED

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